

AMENDMENT TO THE DRAWINGS

Please add new sheet 14, FIG. 14, to the drawings to illustrate a confirmation bookmark while a video presentation is presented to a user. A proposed formal new sheet is enclosed herewith. Applicants respectfully submit that no new matter is added.

REMARKS

This is a full and timely response to the Final Office Action mailed on May 3, 2005. Claims 77-78, 80, 82-87, 89-101, and 110-121 are pending in the present Application. Reconsideration and allowance of the Application and presently pending claims are respectfully requested. Applicants should not be presumed to agree with any statements made in the Office Action regarding the rejections and objections made in the Office Action unless otherwise specifically indicated by Applicants.

I. Claim of Priority

Applicants are not addressing the validity of all assertions made in the Office Action regarding the priority of this Application. Therefore, Applicants should be not presumed to agree with any statements made in the Office Action regarding the priority of the Application unless otherwise specifically indicated by Applicants.

II. Response to Claim Rejections Under 35 U.S.C. §112

Claims 120 and 121 stand rejected under 35 U.S.C. §112, second paragraph, for failing to comply with the written description requirement. Accordingly, claims 120 and 121 are amended, herein, to recite “outputting . . . a portion of said video presentation as a television signal after the information related to the visual scene has been stored in the memory.” Therefore, these rejections related to claims 120 and 121 are obviated and Applicants respectfully request these rejections be withdrawn.

III. Response to Claim Rejections under 35 USC § 103

Claims 77, 78, 80, 82-87, 89-101, 110-113, and 115-121 stand rejected under 35 USC § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,628,302 to *White, et al.* in view of U.S. Patent No. 6,289,346 to *Milewski, et al.* Claim 114 stand rejected under 35 USC § 103(a) as being allegedly unpatentable over *White* in view of *Milewski*, and in further view of U.S. Patent No. 6,614,988 to *Sampsell*.

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the

reference must suggest all features of the claims to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

A. Claim 80

Claim 80 recites:

A method implemented by a television set-top terminal (STT) coupled via a bi-directional communication network to a server located remotely from said STT, said method comprising steps of:

- receiving via a tuner in the STT a video presentation provided by the server;
- outputting by the STT at least a portion of the video presentation as a television signal;
- receiving a first user input associated with a visual scene contained in the video presentation;
- storing information related to said visual scene in a memory of the STT responsive to receiving the first user input;
- outputting by the STT at least another portion of the video presentation as a television signal after the information has been stored in the memory of the STT;
- receiving a second user input configured to request said visual scene in said video presentation after the STT has output the at least another portion of the video presentation;
- outputting by the STT a television signal comprising a portion of said video presentation starting from a location corresponding to said visual scene responsive to the second user input, wherein the location corresponding to said visual scene is identified by the STT using the information related to said visual scene;
- receiving a user input configured to assign a character sequence to said visual scene in said video presentation;***
- storing data corresponding to said character sequence in a memory of the STT responsive to receiving the user input configured to assign a character sequence; and***
- providing said character sequence simultaneously with an image corresponding to said visual scene responsive to subsequent user input;***
- wherein said user input configured to assign a character sequence is received while said video presentation is being presented to said user; and***
- wherein the above steps are executed by the STT.***

(Emphasis Added)

i. Previous Office Action

The previous Office Action stated that “the combination of elements claims 76 and 79 further including the limitation of claim 80 wherein the assigning of a bookmark name during the playback of the video-on-demand presentation are not taught, disclosed, or fairly suggested by the art of record.” (Page 21, paragraph 10, Office Action, Paper No. 8). In this regard, claim 80 was amended in the previous response to include the limitation of claims 76 and 79 and thus, put claim 80 in condition for allowance.

ii. White does not disclose or suggest performing bookmarking operations.

The Office Action admitted that *White* “does not disclose or suggest that the viewer may perform bookmarking operations in conjunction with the distributed programs as is understood in the art.” (Office Action, page 10).

In addition, Applicants submit that *White* further does not disclose or suggest a method implemented by an STT that includes the steps of “receiving a user input configured to assign a character sequence to said visual scene in said video presentation; storing data corresponding to said character sequence in a memory of the STT responsive to receiving the user input configured to assign a character sequence; providing said character sequence simultaneously with an image corresponding to said visual scene responsive to subsequent user input; wherein said user input configured to assign a character sequence is received while said video presentation is being presented to said user, and wherein the above steps are executed by the STT,” as recited in claim 80.

In this regard, the Office Action uses *Milewski* to remedy *White*.

iii. The *Milewski* reference

- a. *Milewski* does not disclose or suggest that all steps as disclosed in claim 80 are executed by the STT.

Applicants respectfully submit that *Milewski* does not disclose or suggest a method implemented by an STT that includes the steps of “receiving a user input configured to assign a character sequence to said visual scene in said video presentation; storing data corresponding to said character sequence in a memory of the STT responsive to receiving the user input configured to assign a character sequence; providing said character sequence simultaneously with an image corresponding to said visual scene responsive to subsequent user input; wherein said user input configured to assign a character sequence is received while said video presentation is being presented to said user; and wherein the above steps are executed by the STT,” as recited in claim 80.

Furthermore, the Final Office Action asserted that *Milewski* discloses “the embodiment ‘outputs . . . a television signal comprising a portion of said video presentation starting from a location corresponding to said visual scene responsive to the second user input, wherein the location corresponding to said visual scene is identified by the STT using the information related to said visual scene. . . .’ ([*Milewski*,] Col 2, Lines 27-30).” (Final Office Action, Page 11, Lines 11-12 and 19-20). Applicants respectfully disagree.

For example, the phrase “by the STT” after “outputs” was left out when citing this element of claim 80. The full claim element should have read:

outputting by the STT a television signal comprising a portion of said video presentation starting from a location corresponding to said visual scene responsive to the second user input, wherein the location corresponding to said visual scene is identified by the STT using the information related to said visual scene.

(Emphasis Added, Instant Application, Claim 80, Element 7)

Accordingly, a prima facie case of obviousness cannot be established based on *White* in view of *Milewski*. Applicants respectfully request that claim 80 be allowed and the rejection be withdrawn.

- b. *Milewski and Gibbon* do not disclose or suggest that all of the steps disclosed in claim 80 are executed by the STT.

Gibbon does not remedy the deficiency of *Milewski* that all the method steps of claim 80 are executed by the STT. Applicants respectfully submit that *Milewski and Gibbon* do not disclose or suggest that the steps disclosed in claim 80 are executed by the STT. The Office Action does not address *Gibbon* with respect to disclosing that the steps of claim 80 are executed by the STT. The Office Action alleges as follows:

“In connection with the particular composition of the personalized web page comprising the bookmarked segments, the *Milewski et al.* reference is unclear. The reference, however, expressly incorporates by reference the *Gibbon et al.* reference (US Pat No. 6,098,082) (Col. 5, Lines 47-64). The *Gibbon et al.* reference discloses that it is known in the art to ‘provide ... [a] character sequence simultaneously with an image corresponding to ... [a] visual scene.’ Furthermore, the display of a bookmarked image with user defined descriptive information is commonly known in the art, as evidenced by the art of record.”

(Final Office Action, page 12)

Applicants respectfully disagree with the allegation in the Final Office Action. In fact, *Milewski* discloses as follows:

“One method for designating URLs for particular portions of archived programs is to use an algorithm that monitors the “fade outs” in a broadcast program, e.g., the commercial breaks. The algorithm would segment the broadcast program by utilizing the fade outs in the program. Each segment between fade outs would be assigned a unique URL. Therefore, by knowing the time of interest for a particular portion of a program, and therefore knowing when this portion of interest occurred in relation to the start of the program, server 120 could access the segmented portion of the archived program that correlated to the time of interest and retrieve the URL for this segment of the program. This methodology is disclosed in the commonly owned pending U.S. patent application Ser. No. 08/679,976, filed Jul. 15, 1996, titled ‘Method for Providing a Compressed Rendition of a Video Program in a Format Suitable for Electronic Searching and Retrieval.’ This patent application is incorporated by reference herein in its entirety.”

Gibbon apparently discloses that “[a] compressed rendition of a video program is

provided in a format suitable for electronic searching and retrieval.” (Abstract). Applicants respectfully submit that Milewski and Gibbon do not disclose or suggest providing a character sequence simultaneously with an image corresponding to said visual scene responsive to subsequent user input. Accordingly, a prima facie case of obviousness cannot be established based on *White* in view of *Milewski*. Applicants respectfully request that claim 80 be allowed and the rejection be withdrawn.

- iv. Milewski does not disclose or suggest a character sequence is assigned to the video program while the video presentation is presented to the user.

In addition to the main argument above that *White* in view of *Milewski* does not disclose a system where the STT performs all processing functions, Applicants wish to respond to one of the arguments made in the Final Office Action. In no way does this imply that Applicants agree with any other statements that are not directly addressed in this document.

The Final Office Action stated that *Milewski* “explicitly teaches that the ‘user could also input descriptive data . . . for inclusion on the web page once the URL is determined and stored on the web page’ (Col 7, Lines 56-59).”(Office Action, Page 4). However, in no way does this statement disclose the claimed limitation that the “user input configured to assign a character sequence is received while the video presentation is presented to the user....” Nowhere does *Milewski* disclose an assignment of “a character sequence . . . while the video presentation is presented to the user.” Respectfully, the argument made Final Office Action is simply making an impermissible assumption that equates the phrase “once the URL is determined” with the claimed limitation “while the video presentation is presented to the user.”

In this regard, Applicants respectfully submit that the argument made in the Final Office Action is using impermissible hindsight using the Applicant’s structure as a template and reconstructing the claims from the cited references. Given the lack of a suggestion or motivation contained in the references for the proposed modification, it appears clear that the only suggestion or motivation comes from Applicants’ own disclosure. As is well established in the law, such hindsight to the Applicants’ own disclosure is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the references to fit the parameters of the claims).

Unlike the *Milewski* reference, the present claim 80 is clear and fully discloses the additional claimed limitation that a character sequence is assigned to the video program while the video presentation is presented to the user. Consequently, Applicants respect that *Milewski* does not disclose or suggest the above-quoted steps as recited in claim 80. Accordingly, a prima facie case of obviousness cannot be established based on *White* in view of *Milewski*. Applicants respectfully request that claim 80 be allowed and the rejection be withdrawn.

B. Independent claims 96, 110, 112, 115, 116, 120 and 121

Applicants submit that independent claims 96, 112, 115, 116, 120 and 121 are also allowable since they each include the element that the steps be performed by the STT. In addition, claim 110 includes “identifying by the STT a plurality of locations in a motion video presentation . . . ; associating by the STT a plurality of respective names with the plurality of locations . . . ; outputting by the STT a first television signal configured to encode the first name and an image corresponding to the first location; outputting by the STT a second television signal responsive to user input received while the first television signal was being output by the STT . . .” This claim is allowable because each step of this claim is executed “by the STT.” Additionally, the last two elements of claim 110, “outputting by the STT a first television signal configured to encode the first name and an image corresponding to the first location; outputting by the STT a second television signal responsive to user input received while the first television signal was being output by the STT . . . ,” were **not addressed** in the Final Office Action.

Applicants respectfully submit that independent claims 96, 110, 112, 115, 116, and 120-121 contain allowable subject matter. Consequently, Applicants respectfully request that claims 96, 110, 112, 115, 116, and 120-121 be allowed and the rejection be withdrawn.

C. Dependent Claims

Because independent claims 80, 96, 110, 112, 115, 116, and 120-121 are allowable over the cited art of record, dependent claims 77-78, 82-87, 89-95, 97-101, 111, 113-114 and 116-121 are allowable as a matter of law for at least the reason that dependent claims 77-78, 82-87, 89-95, 97-101, 111, 113-114 and 116-121 contain all features and elements of their respective independent base claims. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection

to dependent claims 77-78, 82-87, 89-95, 97-101, 111, 113-114 and 116-121 should be withdrawn for at least this reason, among others.

IV. Official Notice, Well-Known, and other similar Languages in the Office Action

Applicants respectfully traverse all Office Notices and Well-known allegations made in the Office Action and submit such should not be considered well-known because the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions. The Office Action alleges that “the viewer may perform bookmarking operations in conjunction with distributed programs as understood in the art.”(Office Action, Page 6) The Office Action also alleges that “it is known in the art to ‘provide ... [a] character sequence simultaneously with an image corresponding to ... [a] visual scene. Furthermore, the display of book marked image with user defined descriptive information is commonly known in the art, as evidenced by the art of record.” (Office Action, Page 6) The Office Action has taken “Official Notices as to the existence of subscription based video repositories with associated rental access periods that expire.” (Office Action, Page 5) The Office Action alleges that “the display of a plurality of bookmarked images with associated descriptive information is commonly known in the art.” (Office Action, Page 6) The Office Action also alleges that “it is known in the art to provide an ‘image corresponding to the first location’ and the ‘second location’.” (Office Action, Page 7) The Office Action further alleges that “As is well known in the art, a WebTV® terminal is effectively a PC-TV that facilitates both the ability to browse the Internet and watch television programming through an integrated platform.” (Office Action, Page 7) The Office Action further alleges that there are “well-known browser control functions such as those associated with bookmarking images for later retrieval.” (Office Action, Page 7) The Office Action further alleges that “it is known in the art to utilize a video segment labeling system wherein ‘at least one of the plurality of names was selected by a respective user input from a list of names provided by the STT.’” (Office Action, Page 7)

According to MPEP 2144.03, "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." MPEP 2144.03 also states that "If such notice is taken, the basis for such reasoning must be set forth explicitly. The Office Action must provide specific factual findings predicated on sound

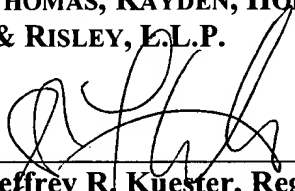
technical and scientific reasoning to support his or her conclusion of common knowledge."

Accordingly, Applicants respectfully traverse the above conclusions and submit that the subject matter noted above should not be considered well known because the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions. Accordingly, Applicants submit that it has not been shown that the material asserted to be well known is capable of instant and unquestionable demonstration as being well-known.

CONCLUSION

Applicants respectfully maintain that the currently pending claims 77-78, 80, 82-87, 89-101, and 110-121 are in condition for allowance. Should the Examiner have any comments or suggestions that would place the subject patent application in better condition for allowance, he is respectfully requested to telephone the undersigned attorney at (770) 933-9500.

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**



Jeffrey R. Kuester, Reg. No. 34,367
Attorney for Applicants

Thomas, Kayden, Horstemeyer & Risley, LLP
100 Galleria Parkway, NW
Atlanta, GA 30339
Ph: (770) 933 - 9500
Fax: (770) 951 - 0933